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| 10/532,712 | 11/16/2005 | Masayuki Satake | 052519 | 8960 |
| 38834 7590 04/16/2009 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036 | | | | |
| EXAMINER HUANG, CHENG YUAN | | | | |
| ART UNIT 1794 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/532,712

Applicant(s)

SATAKE ET AL.

Examiner

CHENG HUANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 14-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-850)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 20050720, 20051227, 20081117

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-9 and 14-15, drawn to an adhesive-type optical film.

Group II, claim(s) 10-13 and 16, drawn to a process of making an adhesive-type optical film.

2. The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature of extrusion is not commonly shared between the inventions of Group I and of Group II.

3. During a telephone conversation with Nicolas E. Seckel on February 17, 2009 a provisional election was made **without** traverse to prosecute the invention of Group I, claims 1-9 and 14-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 10-13 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

6. In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained.

Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Specification

7. The amendment filed December 27, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Amendment for Page 40, line 12 of Specifications regarding changes to the draw ratio from 1.3 to 3 and amendment for Page 54, line 9 of Specifications regarding changes to the weight average molecular weight from 1,000,000 to 1,100,000 do not have support.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

8. Claim 2-9 and 14-15 are objected to because of the following informalities: Regarding claim 9, "An" appears misspelled as "A". Regarding claims 2-9 and 14-15, the first word of each claim "An" should be changed to "The" for proper antecedent basis.
9. Appropriate correction is required.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-9 and 14-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

12. The addition of the word “type” in “adhesive-type” extends the scope of the claims so as to render them indefinite since it is unclear what “type” is intended to convey. The addition of the word “type” to the otherwise definite expression renders the definite expression indefinite by extending its scope. *Ex parte Copenhagen*, 109 USPQ 118 (Bd. App. 1955).

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 1-9 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Atagi (JP2000214324A).

15. Regarding claim 1, Atagi teaches an adhesive-type optical film (optical film 3) comprising an optical film (optical film 1, paragraph [0012]) and an adhesive layer (adhesive layer 2, paragraph [0012]) on at least one side of the optical film (Fig. 1), wherein at least a portion of an edge of the adhesive layer is an inside edge that is located on the inside of an edge line of the optical film (Fig. 1).

16. The recitation “laminated” is a method limitation and does not determine the patentability of the product, unless the process necessarily results in articles that are structurally or compositionally distinguishable from those of the prior art. The claimed adhesive-type optical film would be expected to encompass the film taught by Atagi since Atagi discloses the claimed

structure of an optical film having an adhesive layer on one side of the optical film. Therefore the prior art article would be expected to be identical to or substantially identical to those encompassed by the claim. The Applicant has failed to demonstrate that the process limitation in a product claim necessarily does not encompass the article of the cited art. Absent persuasive evidence a rejection is appropriate. MPEP 2113.

17. Regarding claim 2, Atagi teaches an adhesive-type optical film (optical film 3, paragraph [0016]) further comprising a release film (protection film 25, paragraph [0026]) and a second adhesive layer (pressure sensitive adhesive layer 23, paragraph [0025]) (Fig. 6).

18. Regarding claim 3, Atagi teaches an adhesive-type optical film (optical film 3, paragraph [0012]) wherein a portion of the inside edge in cross section (edge of adhesive 2, paragraph [0007]) extends to the vicinity of the edge line of the optical film (edge of phase difference film 24, paragraph [0025]) (Fig. 6).

19. Regarding claims 4, 5, 14, and 15, Atagi fails to disclose an adhesive-type optical film (optical film 3) having the claimed convex and concave shapes of the inside edge of the adhesive. However, these limitations are regarded as changes in shape and are generally recognized as a design choice and as being within the level of ordinary skill in the art, absent unexpected results. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). MPEP 2144.04 (IV).

20. Regarding claim 6, Atagi teaches an adhesive-type optical film (optical film 3, paragraph [0012]) wherein the field of the optical film projected from the adhesive layer's end face may be along the entire perimeter of the film (paragraphs [0013]-[0016]) which corresponds to the inside edge being formed on at least one-half of the total perimeter of the adhesive layer.

21. Regarding claim 7, Atagi teaches an adhesive-type optical film (optical film 3, paragraph [0012]) wherein the inside edge is formed on the whole of the edge line of the adhesive layer (Fig. 6).
22. Regarding claim 8, Atagi teaches an adhesive-type optical film (optical film 3, paragraph [0012]) wherein a distance between the inside edge and the edge line of the optical film is at most about 150 μm (paragraph [0013]) which overlaps the claimed range of 10 to 300 μm .
23. Regarding claim 9, Atagi teaches an image display device (liquid crystal display) comprising the adhesive-type optical film (optical film 3, paragraph [0012]) (paragraph [0002]).

Conclusion

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.
25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

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like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang

Examiner, Art Unit 1794

March 17, 2009

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794